

REMARKS

The Official Action mailed April 1, 2009, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on May 12, 2006.

A further Information Disclosure Statement is submitted herewith and consideration of this Information Disclosure Statement is respectfully requested.

Claims 1-16 are pending in the present application, of which claims 1-3 and 9-11 are independent. Claims 1-3 and 9-11 have been amended to better recite the features of the present invention. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action rejects claims 1, 2, 4, 5, 7-10, 13, 15 and 16 as anticipated by JP 2003-287704 to Okamoto. The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claims 1 and 9 have been amended to recite that two lenses are used as condensing lenses and used to shape the laser beam after passing through the beam homogenizer, which is supported in the present specification at least by paragraphs [0064] and [0065] of the pre-grant publication of the present application, i.e. U.S. Publication No. 2007/0063226, and Figure 2. Specifically, claim 1 recite changing a first laser beam into a second laser beam whose intensity distribution is homogenized by passing through a beam homogenizer; and making the second laser beam pass through a first condensing lens and a second condensing lens after passing through the

beam homogenizer, and claim 9 has been amended to recite a first condensing lens for condensing the laser beam which has passed through the beam homogenizer; and a second condensing lens for condensing the laser beam which has passed through the first condensing lens.

Independent claims 2 and 10 have been amended to recite that the laser beam which has passed through the beam homogenizer is condensed on a plane and that a condensing lens is disposed at a position where the plane and the irradiation surface are in a conjugate relation, which is supported in the present specification at least by paragraphs [0078], [0079] and [0080]. For example, claim 2 has been amended to recite changing the second laser beam into a third laser beam by condensing the second laser beam on a plane by using a first condensing lens; making the third laser beam enter an irradiation surface through a second condensing lens; and moving the third laser beam relative to the irradiation surface, where the second condensing lens is disposed at a position where the plane and the irradiation surface are in a conjugate relation. Claim 10 has been amended to recite a condensing lens for condensing the laser beam which has passed through the beam homogenizer on a plane; and means for moving an irradiation surface relative to the laser beam, where the condensing lens is disposed at a position where the plane and the irradiation surface are in a conjugate relation.

The Applicant respectfully submits that Okamoto does not teach the above-referenced features of the present invention, either explicitly or inherently. Since Okamoto does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

Paragraph 4 of the Official Action rejects claims 3 and 11 as obvious based on the combination Okamoto and U.S. Patent No. 6,393,042 to Tanaka or U.S. Patent No. 6,524,977 to Yamazaki. The Applicant respectfully submits that a *prima facie* case of

obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2144.04, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claims 3 and 11 have been amended to recite that the projecting lens is disposed at a position where the slit and the irradiation surface are in a conjugate relation, which is supported in the present specification at least by paragraphs [0258], [0259] and [0260]. The Applicant respectfully submits that Okamoto, either alone or in combination with Tanaka '042 or Yamazaki, does not teach or suggest the above-referenced features of the present invention.

Paragraph 5 of the Official Action rejects dependent claims 6 and 14 as obvious based on the combination Okamoto and U.S. Patent No. 6,545,248 to Tanaka. The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

Please incorporate the arguments above with respect to the deficiencies in Okamoto. Tanaka '248 does not cure the deficiencies in Okamoto. The Official Action relies on Tanaka '248 to allegedly teach the features of the dependent claims. Specifically, the Official Action relies on Tanaka '248 to allegedly teach "a non-linear optical element to convert a fundamental into a second harmonic" (page 3, Paper No. 20090327). However, Okamoto and Tanaka '248, either alone or in combination, do not teach or suggest the above referenced features of the present invention. Since Okamoto and Tanaka '248 do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 are in order and respectfully requested.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c), and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,


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